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Fulbright & Jaworski L.L.P.



LUD 5531.1 DIV(10101429)-NDH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Thierry Boon-Falleur, et al.  
Serial No. : 09/782,745  
Filed : February 13, 2001  
For : ISOLATED NUCLEIC ACID MOLECULES WHICH ENCODE  
GAGE GENES AND USES THEREOF  
Group Art Unit : 1644  
Examiner : M. DiBrino

May 16, 2003

Hon. Commissioner of Patents  
Washington, D.C. 20231  
Attn: Technology Center Director  
Technology Center 1600

PETITION FROM  
FINAL DECISION  
REQUIRING RESTRICTION  
IN A PATENT APPLICATION  
(37 CFR §1.144, MPEP 818.03, MPEP 1002.02(c)).

Pursuant to 37 CFR §1.144, applicants hereby petition from the final decision requiring restriction in this application.

Applicants traversed the requirement and requested reconsideration on May 22, 2002.

No fee is believed due in connection with this petition, but if fees are, in fact due, authorization is given to charge these to Deposit Account 500624.

A Notice of Appeal has not been filed, so this petition is timely filed.

The facts surrounding this case are the following. Applicants presented claims 32-40 in a Second Preliminary Amendment, dated May 2, 2001. Claim 32, as set forth originally recited the following:

"An isolated nucleic acid molecule which encodes a GAGE tumor rejection antigen precursor the amino acid sequence of which is set forth in SEQ ID NO: 27, 28, 29, 30 or 31."

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The examiner required restriction to one of SEQ ID NOS: 27, 28, 29 30 and 31. The examiner also asked applicants to correlate nucleotide sequences to the amino acid sequences.

Applicants elected SEQ ID NO: 27, with traverse, and pointed out that SEQ ID NO: 14 encoded SEQ ID NO: 27. See the "Response to Restriction Requirement" dated May 22, 2002.

In an office action, dated August 9, 2002, the examiner made the restriction requirement final, and held claims that did not recite specific nucleotide sequences to be non-enabled.

As a result, applicants cancelled all of the claims then pending, and presented claims 41-49. Claim 41 reads:

"An isolated nucleic acid molecule which encodes a GAGE tumor rejection antigen precursor, the nucleotide sequence of which is set forth at SEQ ID NO: 14, 15, 16, 17, or 18."

The examiner, in a final rejection has objected to claims 41-48, because claim 41 contains SEQ ID NOS: 15-18, which correspond to non-elected subject matter.

Applicants petition from the restriction because it is believed that it is improper.

MPEP 803.04 states, in relevant part:

"Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR §1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application ... It has been determined that normally 10 sequences constitute a reasonable number for examination purposes. Accordingly, in most cases up to ten independent and distinct nucleotide sequences will be examined in a single application... In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten."

In the present case, only 5 sequences are claimed. Figures 4A-B, GAGE-2, 3, 4, 5 and 6 are presented, and correspond to SEQ ID NOS: 15-18 (GAGE 1 is not claimed in claim 41). There is an extremely high degree of identity amongst SEQ ID NOS: 15-18, as figures 4A-4B show.

LUD 5531.1 DIV(10101429)-NDH

The amino acid sequences of the proteins encoded by these nucleotide sequences do not show exceptional differences. None are claimed, none are recited in the application, and none have been pointed out by the examiner.

It is believed that MPEP 803.04 controls in the present case, especially in the absence of any of the showings which the regulations permit for examination of less than 10 sequences.

In view of this, it is believed that the finality of the restriction requirement is improper, and it is respectfully requested that it be withdrawn.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.



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